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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,436	12/16/2004	Haruyasu Yawata	2553-USP-PCT-US	8531

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APPLIED MEDICAL RESOUCES CORPORATION

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EXAMINER

ANDERSEN, MICHAEL T

ART UNIT

PAPER NUMBER

3734

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/518,436

Applicant(s)

YAWATA ET AL.

Examiner

M. Thomas Andersen

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/16/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Priority*

Acknowledgement is made of the claim to benefit of provisional application number 60/398,189, filed on 07/23/2002.

### *Information Disclosure Statement*

The information disclosure statement (IDS) received on 12/16/2004 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner will consider the information disclosure statement.

### *Claim Objections*

Claim 18 is objected to because of the following informalities: "jaws" in line 3 should likely read "jaw". Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-2, 4-9, 15-16, and 18-23** are rejected under 35 U.S.C. 102(b) as being anticipated by **Dicesare et al.**, U.S. Patent No. **5,904,693** (hereinafter "Dicesare").

Dicesare discloses a laparoscopic clip applicator having a disposable cartridge including an elongate tube (col. 2, lines 55-56), a pair of opposing jaw members extending outwardly from the distal end of the elongate tube (see e.g. figures 3 and 15), a one-way ratchet mechanism (col. 2, lines 42-45), a reusable actuating mechanism

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(see e.g. col. 2, lines 8-9). The actuating mechanism comprises a main body and an actuating handle (see e.g. figures 1, 3, 15, and 20). The disposable cartridge further comprises a push member (see e.g. col. 4, lines 12-15) for advancing the clips into the jaw members; a biasing or retaining spring (see e.g. col. 2, line 30-35); a drive coupling connected to a sliding ratchet pawl for engaging with mating teeth formed on an inner surface of the elongate tube (see e.g. figures 18-19), also having a central connection.

The actuating mechanism can be said to further comprise a plurality of tips and an actuating handle, and the cartridge further comprises a jaw loader for advancing the clip into the jaw members and a drive bushing (see e.g. col. 2 line 60 – col. 3 line 13).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dicesare, as applied to claims 1 and 15 above. Dicesare does not expressly disclose forming the ratchet mechanism from injection molded plastic. However, it is common to form surgical devices including ratchet mechanisms out of plastic because of its light weight.

Claims 10-14 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dicesare. Dicesare does not expressly disclose the correlating method of his apparatus. However, it would have been obvious to use the device

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disclosed by Dicesare to position or orient the clip applier, manipulate the jaw members, close the jaw members and clip over the object to be clipped, remove the clip applier from the body, and retract the jaw loader to allow the next clip to be fed into the jaw members. It would have been obvious to perform this method with Dicesare's device because the device was designed to perform such a method.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Thomas Andersen whose telephone number is (571) 272-8024. The examiner can normally be reached on M-F 8AM-4:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Thomas Andersen

July 17, 2006



MICHAEL J. HAYES  
**SUPERVISORY PATENT EXAMINER**